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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,630	05/26/2000	Robert McKinnon JR.	5925.36003	7855

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EXAMINER

ELOSHWAY, NIKI MARINA

ART UNIT	PAPER NUMBER
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3727



DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/579,630	Applicant(s) MCKINNON, ROBERT	
	Examiner Niki M. Eloshway	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,12,13,15-35,37,39,40,42,44 and 58-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,12,13,15-35,37,39,40 and 58-75 is/are rejected.
- 7) ☒ Claim(s) 42, 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/8/03, 5/12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Introduction

1. In view of the Reply Brief filed on February 16, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



Nathan Newhouse, SPE
AU 3727

NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER

Claim Rejections.- 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 5, 6, 13, 18, 19, 25, 39, 40, 59, 60, 62, 69, 72, 74 and 75 have been rejected under 35 U.S.C. 102(b) as being anticipated by Hauffe et al. (U.S. 3,921,449). Hauffe et al. teaches a lid 31, with recesses shown at number "31" in figure 2.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 4, 9, 12, 15-17, 37 and 58 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586). Hauffe et al. teaches a lid 31, with recesses shown at number "31" in figure 2. Hauffe et al. does not teach that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses. Goodwin teaches that it is known to provide a lid with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses (see figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses, as taught by Goodwin, in order to increase the strength of the lid.

6. Claim 2 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586), as applied to claim 1 above, and further in view of Bonnema et al. (U.S. 4,726,490). Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been

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obvious to one having ordinary skill in the art at the time the invention was made to provide the modified lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

7. Claim 7 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Bonnema et al. (U.S. 4,726,490). Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

8. Claims 20-24, 26-35, 61 and 63-65 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449). Hauffe et al. discloses the claimed invention except for the triangular shaped recess. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with a recess having a triangular cross section, in order to give the article a more decorative appearance.

9. Claims 66-68, 70, 71 and 73 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449). Hauffe et al. discloses the claimed invention except for the thickness of the article. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with the thickness being at least 1.5 inches or no greater than two-thirds of the member thickness, since it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

10. Claims 5, 6, 13, 18-35, 39, 40 and 59-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Marthaler (U.S. 5,755,350). Hauffe et al. teaches a molded plastic lid 31. Hauffe et al. does not teach that the lid could be compression molded.

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Marthaler teaches that injection molding, blow molding, thermo molding and compression molding are “conventional manufacturing processes” (col. 3 lines 22-26). Marthaler also teaches that it is well known to mold container components using one of these “conventional manufacturing processes”, such as compression molding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. made by compression molding, as taught by Marthaler, since it is considered a well known, conventional manufacturing process.

Regarding claims 20-24, 26-35, 42, 61 and 63-65, Hauffe et al. discloses the claimed invention except for the triangular shaped recess. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with a recess having a triangular cross section, in order to give the article a more decorative appearance.

Regarding claims 66-68, 70, 71 and 73, Hauffe et al. also does not teach the thickness of the article. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with the thickness being at least 1.5 inches or no greater than two-thirds of the member thickness, since it has been held that “where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

11. Claims 1, 3, 4, 9, 12, 15-17, 37 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586) and Marthaler (U.S. 5,755,350). Hauffe et al. teaches a lid 31, with recesses shown at number “31” in figure 2. Hauffe et al. does not teach that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses and that the lid is compression molded. Goodwin teaches that it is known to provide a lid with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses (see figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. with smaller recesses such that

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the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses, as taught by Goodwin, in order to increase the strength of the lid.

Marthaler teaches that injection molding, blow molding, thermo molding and compression molding are “conventional manufacturing processes” (col. 3 lines 22-26). Marthaler also teaches that it is well known to mold container components using one of these “conventional manufacturing processes”, such as compression molding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. made by compression molding, as taught by Marthaler, since it is considered a well known, conventional manufacturing process.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586) and Marthaler (U.S. 5,755,350), as applied to claim 1 above, and further in view of Bonnema et al. (U.S. 4,726,490). Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Marthaler (U.S. 5,755,350), as applied to claim 5 above, and further in view of Bonnema et al. (U.S. 4,726,490). The modified device of Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

Allowable Subject Matter

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14. Claims 42 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

15. Applicant's arguments filed February 16, 2006 have been fully considered but they are not persuasive. Applicant argues that Hauffe does not teach that the lid is capable of withstanding a load of at least 8000 pounds. It is the examiner's position that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (*Hewlett Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim. Under certain conditions, the Hauffe lid is capable of performing the function set forth in the claims. It cannot be clearly proven that for all circumstances, under any conditions that the Hauffe lid cannot withstand 8000 pounds.

In the new grounds of rejection, the modified Hauffe device would inherently have the strength set forth in the claim, since they are structurally similar and made by the same method.

In addition, the limitation that the lid is capable of withstanding a force of at least 8000 pounds is not supported by the claimed structure. The type of plastic and dimensions of the lid are necessary components to properly support the strength limitation. These necessary components are not set forth in the claim.

In response to Applicants arguments that Marthaler teaches away from compression molding, it has been held that “[t]he use of patents as references is not limited to what the patentees describe as their

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own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998)

In addition, it has been held that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). “A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) Furthermore, “[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Applicant argues that Hauffe does not teach that the lid is compression molded. The limitation regarding the compression molding of the lid is a process limitation within a product claim. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. It is the examiner’s position that “compression molded” is a limitation regarding the process by which the lid made and not a structural limitation.

To the degree it is argued that the compression molding process limitation imparts structure to the claimed lid, the new grounds of rejection recited above are applied to the pending claims. The new grounds of rejection use the secondary reference of Marthaler to show that compression molding is considered a well known conventional molding process in the manufacture of container elements.

Since the “given dimension” of the member has not been defined, the recesses of Hauffe meet this limitation. The “given dimension” of the member is not limited to the overall length of the member, and could be any length equal to or less than the overall length of the member.

Regarding the phrase “compressed plastic”, any force applied to mold a plastic material would compress the plastic.

Regarding the shape of the recesses, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The motivation to reduce the area of the recesses is found within the level of ordinary skill in the art. Increasing the areas of the lid with a greater thickness increases the strength of the lid, since more material is provided in the lid.

Regarding the expectation of success, one of ordinary skill in the molding arts would know that using a well known compression molding technique would result in a stronger lid. Closures can be made by several well known and widely used molding techniques. Each technique has its own benefits and drawbacks. Compression molding uses more material, increases the weight of the lid and increases the strength. These benefits and drawbacks are well known to one of ordinary skill in the art. It is obvious to replace one well known molding technique for another well known molding technique depending on the desired benefits and acceptable drawbacks.

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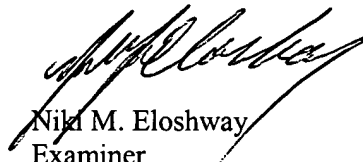
Conclusion

16. THIS ACTION IS NON-FINAL.


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niki M. Eloshway whose telephone number is 571-272-4538. The examiner can normally be reached on Thursdays and Fridays 8 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Niki M. Eloshway
Examiner
Art Unit 3727

nme


NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER